UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,090	01/13/2004	Derek M. Gledhill	37355-180	3084

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EXAMINER
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ART UNIT	PAPER NUMBER
3692	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/756,090	GLEDHILL ET AL.
	Examiner	Art Unit
	MD HATEM H. ALI	3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2007*.
2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,6-11,13-15 and 17-20* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-3,6-11,13-15, 17-20* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   The following is a **Final Action** on merits in response to the communication

received on 12/20/2007.

Acknowledgement

The claims 4-5, 12 and 16 are cancelled. **The claims 1, 2, 6, 8-11, 13-15, 17-18**

and 20 are amended. As such **claims 1-3, 6-11, 13-15, 17-20** are pending.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

3.   **Claims 1-3, 6-11, 13-15, 17-20** are rejected less than 35 U.S.C. 112, first

paragraph, as failing to comply with the written description requirement. The claim(s)

contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention.

In claims 1 and 11, at line 4, the recitation, "additional categories and sub-

categories" are new matter added and cannot be found in original specification.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   **Claims 1-3, 6-11, 13-15 and 17-20** are rejected under 35 U.S.C. 103 (a) as being unpatentable over Horan ET **al** (2003/0225663) in view of **Bergmann** et al (2002/0143682).

      As per claim 1, **Horan** discloses a method of calculating cost basis <u>of an asset</u> comprising:

      <u>acquiring a reallocation of an ownership of the asset from a product system;</u>

      <u>further a</u> categorizing the reallocation into one of a plurality of<u> at least one of;</u> <u>additional</u> categories <u>and sub-categories to establish an enhanced categorization of the</u> <u>reallocation, wherein the reallocation was previously categorized into one of a plurality</u> <u>of categories</u> (para **0041-0042** and **0064**; via the mutual fund recordkeeping and portfolio management system **206 and** para **0041-0042** and **Figs.8** and **10**; via system **1012,** services **1006** and **Fig.9** with product system);

      categorizing the reallocation of the asset into one of a plurality of categories (see para **0042 and 0060**; via shareowner services **1006** on a wide range of levels and multi-asset class with **engine 304**);

      <u>Calculating an adjusted cost basis of the asset based upon at least one of: the</u> <u>asset, the reallocation at least one of: the asset, the reallocation of the ownership of the</u> <u>asset and the enhanced categorization</u> system (see para **0077** and 0099-0100; via workflow system 208 and accounting and management system 806 respectively).<u>; and</u> <u>storing the adjusted cost basis in a management system (Fig. **7**, Data warehouse **312**).</u>

Horan fails explicitly to disclose further a categorizing the reallocation into one of a plurality of at least one of; additional categories and sub-categories to establish an enhanced categorization of the reallocation, wherein the reallocation was previously categorized into one of a plurality of categories.

However, Bergmann being in the same field of invention discloses that a categorizing the reallocation into one of a plurality of at least one of; additional categories and sub-categories to establish an enhanced categorization of the reallocation, wherein the reallocation was previously categorized into one of a plurality of categories (para **0045,** line 27; via asset classes, creating accounts and Boxes 8A, 8B, 8C and 9 categorize assets and calculate after-tax returns)

Therefore, it was obvious to an ordinary skill in the art at the time of invention was made t modify the disclosure of *Horan* and to include the feature of *Bergman* to facilitate adjusting the constraint limits on asset classes.

As per claim 2, Horan discloses the step of codifying the enhanced categorization of the. Reallocation of the ownership of the asset prior to automatically calculating the cost basis change of the asset (para **009-100;** via the accounting and record system 806 through a multi-tier client./server technology inherently codifies the system).

As per claim 3, Horan discloses that the product system is an account (see **Fig.9**; via Open Platform-Products and account system).

As per claim 6, Horan discloses further the steps of:

providing a portfolio having a plurality of assets distributed in one or a plurality of

product systems (see para **0050** and 0052; via reallocate a portfolio);

acquiring a reallocation of an ownership of the asset from a product system (see

para **0041-0042** and 0064; via the mutual fund recordkeeping and portfolio

management system 206);

further a categorizing the reallocation into one of a plurality of at least one of;

additional categories and sub-categories to establish an enhanced categorization of the

reallocation, wen the reallocation was previously categorized into one of a plurality of

categories(see para **0060**;via multi asset class); and

calculating an adjusted cost basis of each of the assets based upon the asset,

the eallocation of the ownership of the asset, and the enhanced categorization. (para

0077 and **0099-0100**; via workflow system **208** and accounting and management

system **806** respectively).

As per claim 7, Horan discloses that the reallocation of each asset is

categorized by the reason for the reallocation (see para **0042**).

As per claim 8, Horan discloses the step of preparing a report relating to the

cost basis change of the asset based on the categorization of the change in the

ownership of the asset , the enhanced categorization (see para 0080 and 0100; via

reporting system **314** and cost basis change).

As per claim 9,. Horan discloses the steps of reconciling the adjusted cost basis

of the asset to the product system (see para **0101**; via open reconciliation system **828**

as in **Fig.8** "Open Recon B2B"); and

preparing a report relating to the cost basis change of the asset (see para 0080

and 0100; via reporting system **314** and cost basis change).

As per claim 10, Horan discloses further the step of utilizing tax lot information

to more accurately determines cost basis change relating to the reallocation of the asset

(see para **0100**; via tax lot basis).

As per claim 11, Horan discloses a system for calculating asset cost basis

changes comprising:

a product system, (see **Fig.8**; via Open Platform with Products);

wherein <u>a reallocation of </u>the ownership of <u>an </u>asset is tracked in an account (para

0041 and 0064; via mutual fund with tracking **tool 206**);

means for extracting information from the account relating to the reallocation <u>and</u>

<u>the enhanced categorization</u> (para **0101**; via open reconciliation system **828** in Fig.8

and record system **806**); and

means for calculating the cost basis change of the asset based on<u> at least one</u>

<u>of:</u> the reallocation, the asset and<u> the enhanced categorization. </u>(see para 0100; via

accounting and management system **806**).

<u>means for storing the adjusted cost basis in a management system **(Fig.7**; Data</u>

<u>Warehouse **312)**</u>

Horan fails explicitly to disclose further a categorizing the reallocation into one of

a plurality of<u> at least one of; additional </u>categories<u> and sub-categories to establish an</u>

<u>enhanced categorization of the reallocation, wherein the reallocation was previously</u>

<u>categorized into one of a plurality of categories.</u>

However, Bergmann being in the same field of invention discloses that a categorizing the reallocation into one of a plurality of at least one of; additional categories and sub-categories to establish an enhanced categorization of the reallocation, wherein the reallocation was previously categorized into one of a plurality of categories (para **0045,** line 27; via asset classes, creating accounts and Boxes 8A, 8B, 8C and 9 categorize assets and calculate after-tax returns)

Therefore, it was obvious to an ordinary skill in the art at the time of invention was made t modify the disclosure of *Horan* and to include the feature of *Bergman* to facilitate adjusting the constraint limits on asset classes.

As per claims 13 -14, Horan discloses enhanced categorizing of the reallocation of the ownership of the asset into one of a plurality of categories based on the reason for the reallocation of the ownership of the asset (see para **0042** and **0060;** via recordkeeping system **1012** shareowner services **1006** on a wide range of levels and multi-asset class with portfolio accounting **engine 304**, inherent with reasons for reallocation of the ownership of the asset).

As per claim 15, Horan discloses the means for calculating the cost basis change of the asset automatically calculates the cost basis change of the asset based on the information extracted from the account (para **0100**; via accounting and management system **806)**

As per the claim 17, Horan discloses means for analyzing the information extracted from the account relating to the asset, the reallocation, and enhanced

<u>categorization</u> prior to calculating the cost basis change of the asset (para **0064**; via portfolio management system **206** includes tools to track positions, perform analytics etc.).

As per claim 18, Horan discloses a portfolio comprising a plurality of assets in the account or a plurality of accounts ; and <u>wherein he </u>means for calculating the cost basis change <u>includes means for calculating the cost basis change</u> of each of <u>at least one of :</u> the plurality of assets <u> and the plurality of accounts </u>(see para **0052**; via a composite of mutual funds); and means for calculating the cost basis change of each of the plurality of assets (see para 010; via accounting and management. system **806**).

As per claim 19, Horan discloses the means for extracting information from the plurality of assets in the account via the management system (see para 0101; via open reconciliation system 828 in **Fig.8** and record system **806**).

As per claim 20, Horan discloses the means for calculating the cost basis change is done automatically (para 0100; via accounting and management system **806**).

Response to Arguments

6.   Applicant's arguments with respect to amended claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.   Accordingly, **THIS ACTION IS MADE FINAL**.   See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD HATEM H. ALI whose telephone number is (571)270-3021. The examiner can normally be reached on 8.00 to 6.00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)? If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MA   Mohamed H Ali
                                                            Examiner
                                                            Art Unit 3692

/Harish T Dass/
Primary Examiner, Art Unit 3692